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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/650,709	05/20/1996	DETLEF ALBIN	7693-002-0	2931

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EXAMINER
DEXTER, CLARK F

ART UNIT	PAPER NUMBER
3724	54

DATE MAILED: 04/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.	Applicant(s)
08/650,709	Albin et al.
Examiner	**Art Unit**
Clark F. Dexter	3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED *Mar 21, 2003* FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

a) ☒ The period for reply expires *5* months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ they raise the issue of new matter (see NOTE below);

(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s):

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attachment.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.

10. ☐ Other:

CLARK F. DEXTER
PRIMARY EXAMINER
ART UNIT 3724

ATTACHMENT TO ADVISORY ACTION (paper no. 54)

Response to Arguments

1. Applicant's arguments filed March 21, 2003 have been fully considered but they are not persuasive.

Regarding the rejection under 35 USC 112, applicant argues that "defining the relative positions of the rolls in terms of the conveying direction does not render the claims indefinite under 35 USC 112, second paragraph." The Examiner respectfully disagrees with applicant's analysis. For example, as cited by applicant, the courts have determined that "a claim may be defined in terms of an unclaimed element (which may or may not be a workpiece) so long as the characteristics of the unclaimed element would be understood by those skilled in the art." It is respectfully submitted that the subject claim recitation would not be clearly understood by those skilled in the art and therefore claiming the invention in terms of the workpiece in the manner presented by applicant is vague and indefinite. For example, the claim requires the smallest distance between the cutting edge of the at least one cross cutting element and the back-up roll to be situated "upstream in a conveying direction of a layer of hydrous polymer gel to be cut at the nip." First, it is respectfully submitted that it is not clear how such a recitation can be met, even by the present invention. For the sake of argument, if the "layer of hydrous polymer gel to be cut at the nip" was taken to be structure, something upstream of that would be spaced away from the nip, particularly since the gel to be cut at the nip would have to be upstream of the nip. Of

course, this does not make sense because the smallest spacing, as best understood, must be at, or substantially at, the nip. Thus, it must be assumed that the gel being referred to in the claim recitation is downstream from the nip and is intended to be put back through the cutting device (or some other intended use that puts the "smallest distance" upstream of the layer of gel). Because it is not readily clear as to what is intended by the subject claim recitation, it is respectfully submitted that the rejection under 35 USC 112 must be maintained.

Regarding the prior art rejection, it is respectfully submitted that, with respect to a workpiece that has been put through the cutting nip of Wilson (i.e., a workpiece that is located downstream of the cutting nip of Wilson so that the "smallest distance" is situated upstream of the workpiece as claimed), the "smallest distance" in Wilson would clearly be upstream of that workpiece. It is respectfully emphasized that the claim never requires the "smallest distance" to be upstream of the crown as argued by applicant. For example, there is no requirement in the claims that the "smallest distance" be upstream with respect to a crown of the back up roll as argued in the second paragraph on page 1 of the response. Rather, the claim requires the "smallest distance" to be "upstream in a conveying direction of a layer of hydrous polymer gel to be cut at the nip." Further, it is not clear as to what is added by the additional recitation "with respect to a crown of the back-up roll," particularly since it seems that if the "smallest distance" is upstream of the gel, it would still be upstream of the gel with respect to the a crown of the back-up roll. It is again emphasized that the claims do not require the "smallest distance" to be upstream of a crown of the back-up roll as argued by applicant. Therefore, it is respectfully

submitted that no claim limitations have been ignored as alleged by applicant, that the claim limitations as best understood have been addressed by the prior art rejection, and that Wilson meets the claimed invention as best understood from the claims.

cfd
April 22, 2003